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EXAMINER

GRAHAM, CLEMENT B

ART UNIT

PAPER NUMBER

3692

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DELIVERY MODE

09/03/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/730,868

Applicant(s)

TIDWELL ET AL.

Examiner

Clement B. Graham

Art Unit

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 5, 15, 24, 26, 37, 45, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Applicant's claims are directed to an algorithm. Specifically, claim 1 recites "comparing", "determining" and ", however these steps are mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, for example) and abstract ideas without a practical application are found to be non-statutory subject matter. Therefore, Applicant's claims are non-statutory as they do not produce a useful, concrete and tangible result.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-45, are rejected under 35 U.S.C. 103(a) as being unpatentable over Carr et al (Hereinafter Carr U.S Pub: 2003/0056104 A1) in view of Rees U.S Pub: 2003, 0023555A1.

As per claim 1, Carr discloses a computerized method for determining whether to authorize the cashing of a payroll check presented to a check-cashing entity, the method comprising:

obtaining with a point-of-sale device installed at a check-cashing entity input about at least one watermark on a payroll check presented for a proposed check-cashing transaction, comparing the input about the watermark with stored data about watermarks determining a risk score based at least in part on the comparison, and determining based at least in part on the risk score whether

to authorize the cashing of the payroll check (see column 1 para 0004 and column 3 para 0030 and 0047 and column 5 lines 0061-62 and column 7 lines claim 27).

Carr fail to explicitly teach displaying with the point-of-sale device an indication of whether to accept the payroll check based on determining whether to authorize the cashing of the payroll check.

However Rees discloses the Pay Port is a point-of-sale data entry device with a PIN-pad or other keyboard, and a check Magnetic Ink Character Recognition (MICR) reader and/or check scanner. It also has an information display for the customer and/or the store clerk. This display could be a simple, one-line display or a larger full-screen display. Optionally, the Pay Port may have a magnetic card reader and/or barcode reader attachment. The Pay Port can contain these functions in a single integrated unit or be linked to other peripherals or devices to perform these functions. The Pay Port is programmed to initiate and process financial services and is connected to the CDE by a dial-up, frame-relay, ISDN, or DSL line in this embodiment.(see column 3 para 0045).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Carr to include displaying with the point-of-sale device an indication of whether to accept the payroll check based on determining whether to authorize the cashing of the payroll check taught by Rees in order to display transaction information.

As per claim 2, Carr discloses. wherein comparing the input with the stored data further comprises determining a degree of similarity between the input and an expected configuration for the watermark (see column 1 para 0004 and column 3 para 0030 and 0047 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 3, Carr discloses wherein determining a risk score based at least in part on the comparison comprises determining a risk score indicative of a degree of similarity (see column 1 para 0004 and column 3 para 0030 and 0047 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 4, Carr discloses wherein determining a risk score based at least in part on the comparison comprises determining a risk score indicative of lower risk when the degree of similarity is greater and determining a risk score indicative of higher risk when the degree of

similarity is less (see column 1 para 0004 and column 3 para 0030 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 5, Carr discloses a computerized apparatus that indicates to an entity whether to accept a check, the apparatus comprising:

a computer processor configured to receive information about at least one authenticating mark on a check presented to an entity, the computer processor further configured to determine a risk score associated with accepting the check, wherein the risk score is based at least in part on the information about the authenticating mark, the computer processor further configured to indicate to the entity whether to accept the check based at least in part on the risk score (see column 1 para 0004 and column 3 para 0030 and 0047 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 6, Carr discloses wherein the authenticating mark is a watermark, barcode, insignia, heat-sensitive mark, security validation number, color scheme, background pattern, micro printing, color shifting ink, holographic strips, or plurality of ultraviolet light sensitive fibers (see column 1 para 0004 and column 3 para 0030 and 0047 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 7, Carr discloses wherein the computer processor determines the risk score based on a degree of similarity between insignia-related input received by the entity and stored information about expected configurations of authenticating marks (see column 1 para 0004 and column 3 para 0030 and 0047 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 8, Carr discloses wherein the computer apparatus determines a risk score indicative of less risk when the degree of similarity is higher (see column 1 para 0004 and column 3 para 0030 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 9, Carr discloses wherein the computer processor is further configured to compare the information about the authenticating mark with stored information about expected configurations of authenticating marks (see column 1 para 0004 and column 3 para 0030 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 10, Carr discloses wherein the computer processor is further configured to receive the information about the authenticating mark from a third party service (see column 1 para 0004 and column 3 para 0030 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 11, Carr discloses further configured to receive the information about the authenticating mark from the entity (see column 1 para 0004 and column 3 para 0030 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 12, Carr wherein the computer processor is further configured to indicate to the entity whether to accept the check based at least in part on information about a check presenter associated with the check (see column 1 para 0004 and column 3 para 0030 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 13, Carr discloses wherein the computer processor is further configured to indicate to the entity whether to accept the check based at least in part on information about an issuer location associated with the check (see column 1 para 0004 and column 3 para 0030 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 14, Carr discloses wherein the computer processor is further configured to indicate to the entity whether to accept the check based at least in part on positive pay information associated with the check (see column 1 para 0004 and column 3 para 0030 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 15, Carr discloses a computerized method that indicates to an entity whether to accept a check, the method comprising:
receiving from an entity information about at least one authenticating mark on a check associated with a proposed check transaction (see column 1 para 0004 and column 3 para 0030 and column 5 lines 0061-62 and column 7 lines claim 27) determining a risk score associated with the proposed check transaction based at least in part on the information about the authenticating mark and indicating to the entity whether to accept the check based at least in part on the risk score (see column 1 para 0004 and column 3 para 0030 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 16, Carr discloses wherein the authenticating mark is a watermark, barcode, insignia, heat-sensitive mark, security validation number, color scheme, background pattern, micro printing color shifting ink, holographic strips, or plurality of ultraviolet light sensitive fibers (see column 1 para 0004 and column 3 para 0030 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 17, Carr discloses wherein comparing the input with the stored data further

comprises determining a degree of similarity between the input and an expected configuration for the authenticating mark (see column 1 para 0004 and column 3 para 0030 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 18, Carr discloses wherein determining a risk score based at least in part on the comparison comprises determining a risk score indicative of a degree of similarity (see column 1 para 0004 and column 3 para 0030 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 19, Carr discloses wherein determining a risk score further comprises determining the risk score based at least in part on biometric information about a check presenter associated with the proposed check transaction (see column 1 para 0004 and column 3 para 0030 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 20, Carr discloses wherein determining a risk score further comprises determining the risk score based at least in part on information about a location associated with the check (see column 1 para 0004 and column 3 para 0030 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 21, Carr discloses wherein the location associated with the check is a location associated with an issuer of the check (see column 1 para 0004 and column 3 para 0030 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 22, Carr discloses wherein the location associated with the check is a location associated with the entity (see column 1 para 0004 and column 3 para 0030 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 23, Carr discloses wherein determining a risk score further comprises determining the risk score based at least in part on positive pay information associated with the check (see column 1 para 0004 and column 3 para 0030 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 24, Carr discloses an apparatus that scores risk associated with a proposed financial transaction, the apparatus comprising:
a computer processor configured to receive information about at least one authenticating mark on a negotiable instrument associated with a proposed financial transaction, the computer processor further configured to determine a risk score associated with the proposed financial transaction

based at least in part on the information about the authenticating mark (see column 1 para 0004 and column 3 para 0030 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 25, Carr discloses wherein the authenticating mark is a watermark, barcode, insignia, heat-sensitive mark, security validation number, color scheme, background pattern, micro printing, color shifting ink, holographic strips, or plurality of ultraviolet light sensitive fibers (see column 1 para 0004 and column 3 para 0030 and 0047 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 26, Carr discloses a computerized method that scores risk associated with a proposed financial transaction, the method comprising: receiving information about at least one authenticating mark on a negotiable instrument presented in association with a proposed financial transaction, and determining a risk score associated with the proposed financial transaction based at least in part on the information about the authenticating mark indicating to an entity whether to accept the negotiable instrument based at least in part on the risk score (see column 1 para 0004 and column 3 para 0030 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 27, Carr discloses wherein the authenticating mark is a watermark, barcode, insignia, heat-sensitive mark, security validation number, color scheme, background pattern, micro printing, color shifting ink, holographic strips, or plurality of ultraviolet light sensitive fibers (see column 1 para 0004 and column 3 para 0030 and 0047 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 28, Carr discloses wherein determining a risk score associated with the proposed financial transaction further comprises considering a comparison of insignia-related input received by an entity associated with the proposed financial transaction and an expected configuration of an authenticating mark (see column 1 para 0004 and column 3 para 0030 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 29, Carr discloses wherein determining a risk score associated with the proposed financial transaction further comprises determining an insignia-related risk score. (see column 1 para 0004 and column 3 para 0030 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 30, Carr discloses wherein determining a risk score associated with the

proposed financial transaction further comprises determining the risk score based at least in part on information about a presenter of the negotiable instrument (see column 1 para 0004 and column 3 para 0030 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 31, Carr discloses wherein the information about the presenter comprises biometric information about the presenter (see column 1 para 0004 and column 3 para 0030 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 32, Carr discloses wherein determining a risk score associated with the proposed financial transaction further comprises determining the risk score based at least in part on information about a location associated with the issuer of the negotiable instrument (see column 1 para 0004 and column 3 para 0030 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 33, Carr discloses wherein determining a risk score associated with the proposed financial transaction further comprises determining the risk score based at least in part on reconciliation information associated with the negotiable instrument (see column 1 para 0004 and column 3 para 0030 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 34, Carr discloses wherein the reconciliation information comprises positive pay information (see column 1 para 0004 and column 3 para 0030 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 35, Carr discloses wherein receiving information about at least one authenticating mark comprises receiving a front and a back image of the authenticating mark (see column 1 para 0004 and column 3 para 0030 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 36, Carr discloses wherein receiving information about at least one authenticating mark comprises receiving a front and a back image of the negotiable instrument (see column 1 para 0004 and column 3 para 0030 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 37, Carr discloses a computerized system that determines whether to authorize a proposed check transaction, the system comprising:
a point-of-sale device installed at a check-cashing entity, wherein the point-of-sale device is configured to obtain data about one or more authenticating marks on a check associated with a

proposed check transaction;
a database of information about authenticating marks (see column 1 para 0004 and column 3 para 0030 and column 5 lines 0061-62 and column 7 lines claim 27) a computer processor configured to receive the data from the point-of-sale device and to compare the data with information stored in the database; and
a check authorization system configured to determine a risk score based at least in part on the comparison, the check authorization system further configured to determine based at least in part on the risk score whether to authorize the check transaction (see column 1 para 0004 and column 3 para 0030 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 38, Carr discloses wherein the point-of-sale device is further configured to obtain a front and a back image of the authenticating mark. (see column 1 para 0004 and column 3 para 0030 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 39, Carr discloses wherein the point-of-sale device is further configured to obtain a front and a back image of the check (see column 1 para 0004 and column 3 para 0030 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 40, Carr discloses wherein the computer processor is located at the check-cashing entity (see column 1 para 0004 and column 3 para 0030 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 41, Carr discloses wherein the computer processor is located at a third party service provider (see column 1 para 0004 and column 3 para 0030 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 42, Carr discloses wherein the third party service provider is configured to transmit information about the comparison to the check authorization system (see column 1 para 0004 and column 3 para 0030 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 43, Carr discloses wherein the third party service provider is configured to transmit information about the comparison to the check-cashing entity (see column 1 para 0004 and column 3 para 0030 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 44, Carr discloses wherein the computer processor is located at the check authorization system (see column 1 para 0004 and column 3 para 0030 and column 5 lines 0061-62 and column 7 lines claim 27).

As per claim 45, Carr discloses a system for indicating to a check-cashing entity whether to accept a check for cashing, the system comprising:
means for receiving from a check-cashing entity information about at least one authenticating mark on a check associated with a proposed check-cashing transaction, means for determining a risk score associated with the proposed check-cashing transaction based at least in part on the information about the authenticating mark and means for indicating to the check-cashing entity whether to accept the check for cashing based at least in part on the risk score (see column 1 para 0004 and column 3 para 0030 and column 5 lines 0061-62 and column 7 lines claim 27).

Conclusion

RESPONSE TO ARGUMENTS

4. Applicant argument filed 6/6/08 has been fully considered but they are not persuasive for the following reasons.
5. In response to Applicant's arguments that Carr the prior art of reference fail to teach or suggest" determine a risk score for a transaction based on information about an authenticating mark such as watermark" the examiner disagrees with Applicant's because these limitations were addressed as stated.

Carr discloses consider an employer who wishes to cut a check to an employee. The employer wishes to minimize the risk of a counterfeiter intercepting the check and making illicit copies. So the employer issues the employee a watermarked identification document. (In some cases the employee will already have a watermarked identification document, such as a watermarked driver's license or passport.) The watermarked identification document includes a unique first identifier. Prior to cutting the check, the employer decodes the watermark embedded in the employee's identification card to obtain the first identifier. The first identifier is used to provide (or formulate) a second identifier. The second identifier is embedded in the employee's check. The check and the employee's watermarked identification document are linked through the first and second watermark identifiers.(see column 6 para 0078 and column 3 para 0047). Therefore it is inherently clear that Applicant's claimed limitations were addressed within the teachings of Carr and the reason for using watermark on checks would have been a risk measure to insure that the check was not stolen or lost or tampered with.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B. Graham whose telephone number is 571-272-6795. The examiner can normally be reached on 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Frantzy Poinvil/
Primary Examiner, Art Unit 3692

CG
Aug 28, 2008